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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,351	10/06/2004	Ernest R. Bodnar	1120U106	9530
3106 7590 06/26/2008 JAMES W. CARSON MACLEOD KNOX WATTS OAKVILLE CORPORTATE CENTER SUITE 700, 700 DORVAL DRIVE OAKVILLE, ON L6K 3V3 CANADA			EXAMINER CAJILIG, CHRISTINE T	
			ART UNIT	PAPER NUMBER
			3633	
			MAIL DATE	DELIVERY MODE
			06/26/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/510,351	<b>Applicant(s)</b> BODNAR, ERNEST R.	
	<b>Examiner</b> CHRISTINE T. CAJILIG	<b>Art Unit</b> 3633	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 8-25,27 and 29-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,26 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/06/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Species 1, claims 1-7, 26, and 28 in the reply filed on 12/26/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 8-25, 27, and 29-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species 2-7, there being no allowable generic or linking claim.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on 10/12/2002. It is noted, however, that applicant has not filed a certified copy of the CA 2,404,320 application as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion,

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unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

The information disclosure statement filed 10/06/04 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

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### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in Canada (CA 2,404,320) on 10/12/2002. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of the above foreign application. A new oath, declaration or application data sheet is required in the body of which the present application should be identified by application number and filing date.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "openings" (emphasis added) in the depressions as claimed in claim 2 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "80" has been used to designate both side walls of the openings 76 (See Figure 13) and a channel (See Figure 12). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "C" in page 11 and "60" in page 12. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: (1) Page 10, line 19, there is no reference number between the parentheses. (2) Page 13, lines 1 and 5-6 make reference to Figure 5; however, reference should be made to Figure 8. (3) Typographical errors are present on page 14, lines 22 and 28, page 15, line 12, and page 17, line 6.

Appropriate correction is required.

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### ***Claim Objections***

Claim 26 is objected to because of the following informalities: Claim 26 recites the limitation "the web axis" in line 13. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 3, and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5, 7, 10, and 18 of copending Application No. 11/652,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elements in claims 1, 2, 3, and 26 of the instant application are included within the co-pending



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claims of the copending application wherein a metal member has a web, flanges, and openings with side portions bent in a axis parallel to a web axis and depressions with openings in said depressions.

Claims 1, 2, 3, 5, and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 17 of copending Application No. 11/020242. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elements in claims 1, 2, 3, 5, and 16 of the instant application are included within the co-pending claims of the copending application wherein a metal member has a web, flanges, and openings with side portions bent in a axis parallel to a web axis and depressions with openings in said depressions. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Bodnar (U.S. Patent No. 5,527,625) herein referred to as Bodnar '625.

Regarding claim 1, Bodnar '625 in Figures 24-25 discloses a steel member for use in supporting structures and having reduced heat transfer characteristics as compared with solid web studs, and characterized by a web (a) defining side edges and an axis (c); a flange (312) on at least one side edge; openings (302) through said web at spaced intervals therealong, of predetermined size and profile, at least a side portion (304, 306) of said web being removed from said opening and remaining attached integrally to said web, and being bent away from said web along axes (d) parallel to said web axis (c).

Regarding claim 3, Bodnar '625 discloses the structure discussed above and further discloses that said side portion (304, 306) defines a channel shape (e) extending along an axis parallel to said web axis.

Regarding claim 4, Bodnar '625 discloses the structure discussed above and further discloses that said openings (302) are of a shape defining a linear side edge (f), and an arcuate side edge (g), said side portion (304, 306) of said web being integral with said linear side edge (f).

Regarding claim 5, Bodnar '625 discloses the structure discussed above and further discloses that there are two said flanges (312) one on each side of said web, being formed at normal to said web, and lips (h) formed along said flanges and normal to said flanges.

Regarding claim 6, Bodnar '625 discloses the structure discussed above and further discloses that openings (302) are arranged in an alternating orientation and struts (308) are defined between said openings, said struts extending diagonally across said member.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Meyer (U.S. Patent No. 6,170,217) herein referred to as Meyer '217.

Regarding claim 1, Meyer '217 in Figures 1 and 2 discloses a steel member for use in supporting structures and having reduced heat transfer characteristics as compared with solid web studs, and characterized by a web (210) defining side edges and an axis (a); a flange (120a, 110) on at least one side edge; openings (c) through said web at spaced intervals therealong, of predetermined size and profile, at least a side portion (d, 220) of said web being removed from said opening and remaining attached integrally to said web, and being bent away from said web along axes (b) parallel to said web axis (a).

Regarding claim 2, Meyer '217 discloses the structure discussed above and further discloses depressions (e) formed in said web at spaced intervals, and an opening (f) formed in said depressions to reduce heat transfer.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bodnar '625.

Regarding claim 26, Bodnar '625 in Figures 24-25 discloses a steel member having a web (a), side edges, and a flange (312) along at least one said side edge and openings (302) through said web wherein said openings (302) are formed in said web at spaced intervals therealong, with one of said openings leaving a side portion of metal attached to said web forming an edge flange (304, 306) along said at least one side edge of said web and forming said side portion out of the plane of said web wherein said side portion is bent along bend lines (d) parallel to the web axis (c). Therefore, the method steps set forth in claim 26 of forming the steel member with the above said structure and bending side portions would have been an obvious if not inherent method of making the steel member having the same structure.

Claims 1, 6, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Folsom (U.S. Patent No. 2,088,781) herein referred to as Folsom '781.

Regarding claim 1, Folsom '781 in Figures 1 and 2 discloses a metal member for use in supporting structures and having reduced heat transfer characteristics as

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compared with solid web studs, and characterized by a web (A) defining side edges and an axis (b); a flange (3) on at least one side edge; openings (4-6) through said web at spaced intervals therealong, of predetermined size and profile, at least a side portion (8) of said web being removed from said opening and remaining attached integrally to said web, and being bent away from said web along axes (a) parallel to said web axis (b), but does not disclose that the member is steel. However, it would have been obvious to one having ordinary skill in the art at the time of invention to use steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960)

Regarding claim 6, Folsom '781 discloses the structure discussed above and further discloses that said openings (406) are arranged in an alternating orientation and struts (7) are defined between said openings, said struts extending diagonally across said member.

Regarding claim 26, Folsom '781 discloses a steel member having a web (A), side edges, and a flange (3) along at least one said side edge and openings (4-6) through said web wherein said openings (4-6) are formed in said web at spaced intervals therealong, with one of said openings leaving a side portion of metal attached to said web forming an edge flange (8) along said at least one side edge of said web and forming said side portion out of the plane of said web wherein said side portion is bent along bend lines (a) parallel to the web axis (b). Therefore, the method steps set forth in claim 26 of forming the steel member with the above said structure and bending

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side portions would have been an obvious if not inherent method of making the steel member having the same structure.

Claims 7 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Folsom '781 in view of Schnitzer (U.S. Patent No. 1,656,871) herein referred to as Schnitzer '871.

Regarding claim 7, Folsom '781 discloses the structure discussed above, but does not disclose openings formed in said web at opposite ends of each said strut to restrict heat transfer through said member. However, Schnitzer '871 discloses a steel having opening (42) formed in a web (22) at opposite ends of each strut (24) to provide a light weight structural member. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the structure of Folsom '781 to have holes on opposite ends of each strut as taught by Schnitzer '871 to provide an even more lightweight structure.

Regarding claim 28, Folsom '781 discloses the method discussed above, and further discloses struts (7) formed extending across said web between said openings and forming slots, but does not disclose slots in said web adjacent each end of each said strut. However, Schnitzer '871 discloses a steel having slots (42) formed in a web (22) adjacent each ends of each strut (24) to provide a light weight structural member. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the Applicant's invention to modify the structure of Folsom '781 to have slots on opposite ends of each strut as taught by Schnitzer '871 to provide an even more

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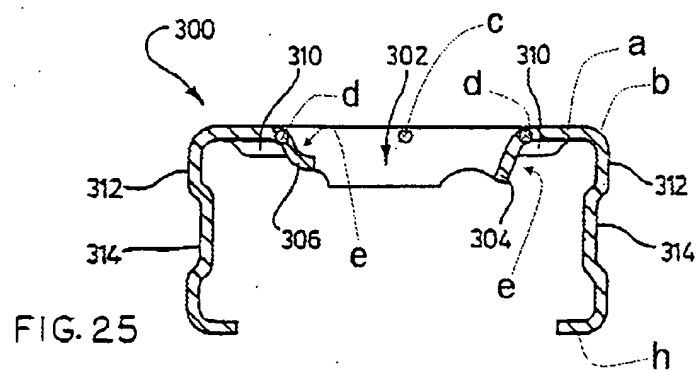
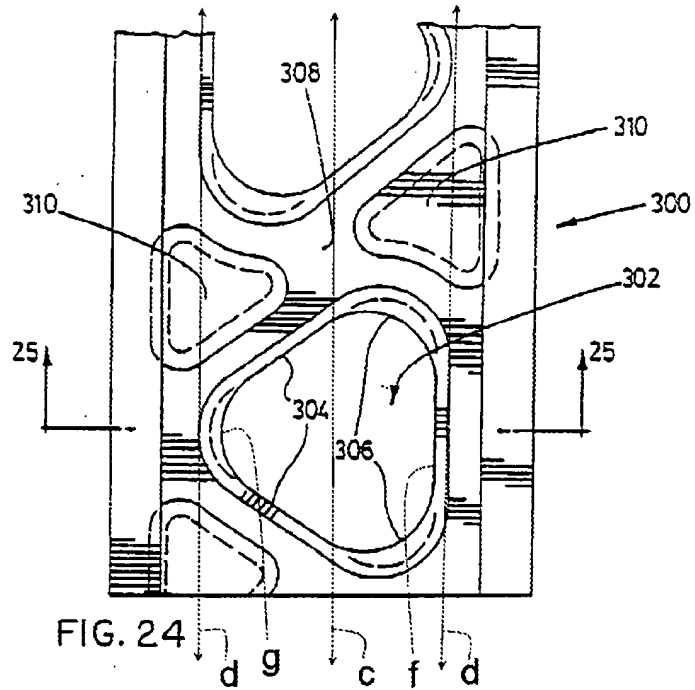
lightweight structure. Therefore, the method steps set forth in claim 28 of forming the steel member with the above said structure of Folsom '781 as modified by Schnitzer '871 would have been an obvious if not inherent method of making the steel member having the same structure.

Claims 1 and 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Rafter (U.S. Patent No. 2,185,384) herein referred to as Rafter '384.

Regarding claim 1, Rafter '384 in Figure 1 discloses a metal member for use in supporting structures and having reduced heat transfer characteristics as compared with solid web studs, and characterized by a web (1) defining side edges and an axis (a); a flange (5) on at least one side edge; openings (2) through said web at spaced intervals therealong, of predetermined size and profile, at least a side portion (3, 4) of said web being removed from said opening and remaining attached integrally to said web, and being bent away from said web along axes (b) parallel to said web axis (a), but does not disclose that the member is steel. However, it would have been obvious to one having ordinary skill in the art at the time of invention to use steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960)

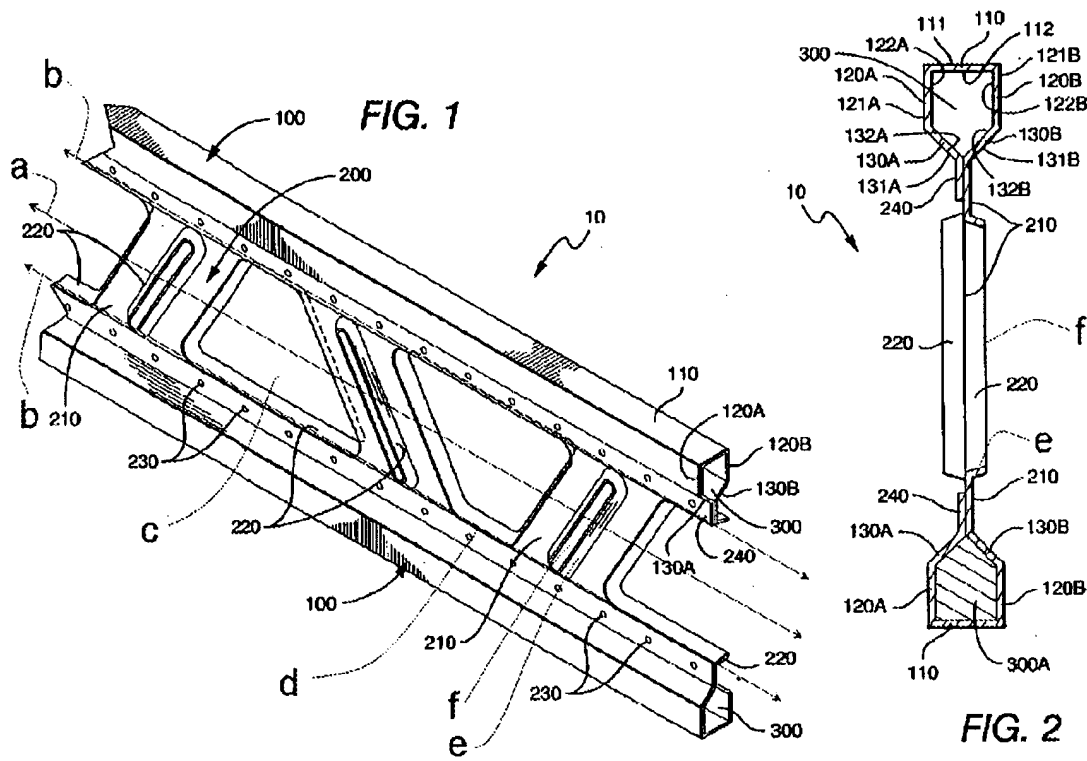
Regarding claim 3, Rafter '384 discloses the structure discussed above and further discloses that said side portion (3, 4) defines a channel shape (created by 3 and 4) extending along an axis (between axes a and b) parallel to said web axis.

**Annotated Figures**

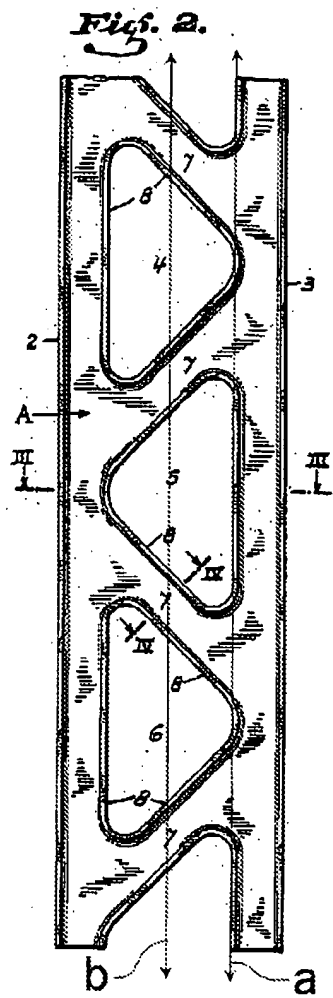


Bodnar '625

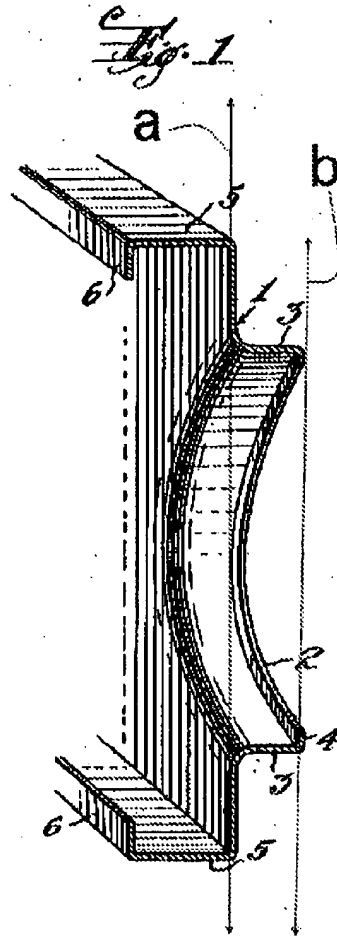




Meyer '217



Folsom '781



Rafter '384

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### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bodnar (US 5592848) steel stud; Klemperer (US 1994716) steel girder; Meyer (US 5157883) metal stud; Rafter (US 2092472) stud; Castle (US 2423682) sheet metal beam; Bodnar (US 4793113) metal stud; Tiffin et al. (US 4016688) beam structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTINE T. CAJILIG whose telephone number is (571)272-8143. The examiner can normally be reached on Monday - Thursday from 8am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Canfield can be reached on (571) 272-6840. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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/C. T. C./

Examiner, Art Unit 3633  
3/11/08

/Robert J Canfield/  
Supervisory Patent Examiner, Art Unit 3635